



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,481	01/16/2004	Peter Navratil	KLR:1016.2025	7575

7590 03/20/2006

Kevin L. Russell
Chernoff, Vilhauer, McClung & Stenzel, LLP
601 SW Second Avenue
Portland, OR 97204-3157

EXAMINER

TANG, MINH NHUT

ART UNIT	PAPER NUMBER
----------	--------------

2829

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-A

Office Action Summary	Application No.		Applicant(s)	
	10/759,481		NAVRATIL ET AL.	
	Examiner		Art Unit	
	Minh N. Tang		2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on January 06, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the U.S. Patent No. 6,777,964 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

2. Claims 1 and 3 are objected to because of the following informalities: it has been held that the recitation that an element is "capable of", "adapted for", "adapted of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Therefore, "capable of" (claim 1, line 4) should be -- for --, and "capable of" (claim 3, line 2) should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Palkuti (U.S.P. 4,575,676).

As to claim 1, Palkuti discloses, in Figs. 1-3, a probe station for testing a device under test (25) comprising a first platen (31) supporting an electrical probe (47); a chuck (41) supporting said device under test (25); a second platen (21) supporting an optical probe (33) for testing optical components (i.e., photodiode and phototransistor formed on the IC 25) on said device under test (25); said first platen (31) positioned above said device under test (25) and said second platen (21) positioned above said device under test (25); at least 70% of the top surface of said second platen (21) terminating in free space when said optical probe (33) is not supported thereon.

As to claims 2, and 4-6, Palkuti discloses in Figs. 1-3, at least 80%, 85%, 90%, and 95% of the top surface of said second platen (21) terminating in free space when said optical probe (33) is not supported thereon.

As to claim 3, Palkuti discloses in Figs. 1-3, said first platen (31) and said second platen (21) are relevant movement with respect to one another.

As to claim 7, Palkuti discloses in Figs. 1-3, said second platen (21) has a greater top surface area than said first platen (31).

As to claim 8, Palkuti discloses in Figs. 1-3, said second platen (21) has a smaller top surface area than said first platen (31).

As to claim 9, Palkuti discloses in Figs. 1-3, said second platen (21) has the same surface area as said first platen (31).

Allowable Subject Matter

5. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the art of record does not disclose nor would it be obvious to modify the art of record so as to include the limitation said first platen is maintained in position with respect to said second platen by gravity such that if said probe station were turned upside down said first platen would freely fall away from said second platen.

Response to Arguments

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Richardson	4,706,019	Electron Beam Test Probe System For Analyzing Integrated Circuits.
Spanziani et al.	5,631,571	Infrared Receiver Wafer Level Probe Testing.
Ishitani et al.	6,734,687	Apparatus For Detecting Defect In Device And Method Of Detecting Defect.

Art Unit: 2829

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh N. Tang whose telephone number is (571) 272-1971. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael M. Fahmy or Robert Pascal can be reached on (571) 272-1705 or (571) 272-1769, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MINH NHUT TANG
PRIMARY EXAMINER

3/14/06